

In re Patent Application of:
CHAPMAN ET AL.
Serial No. **09/596,629**
Filing Date: **June 19, 2000**

REMARKS

Applicants would like to thank the Examiner for the thorough examination of the present application. Applicants would also like to thank the Examiner for the courtesies extended during the telephone interview on November 30, 2004.

Independent Claims 1, 12, 22, 31, 42, 52 and 61 have been amended to more clearly define the present invention over the cited prior art references. In addition, independent Claims 31, 42 and 52 have been further amended to recite "at least one computing device comprising a plurality of software modules" to overcome the 35 U.S.C §101 rejection. The claim amendments and arguments supporting patentability of the claims are presented in detail below.

I. The Claims Are Patentable

The Examiner rejected independent Claims 1, 12, 22, 31, 42, 52 and 61 over the Hager et al. patent in view of the Kuzma patent. The present invention, as recited in amended independent Claim 1, for example, is directed to a method for distributing an invention disclosure over an intranet. The method comprises the steps of creating and submitting an invention disclosure over the intranet, with the invention disclosure including information about an invention and being submitted by an inventor to at least one evaluator via e-mail with a hyperlink to the invention disclosure.

Evaluation comments of the invention disclosure are transmitted by the at least one evaluator via e-mail. Creating the invention disclosure comprises including an attachment therewith, with the attachment having been created separate from the invention disclosure. Independent Claim 1 has been

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amended to recite that the invention disclosure includes information about an invention, and that a portion of the information is included in the attachment.

The method in accordance with the present invention advantageously allows the inventor and evaluators to exchange e-mail messages within the intranet for providing notification and status of the invention disclosure. Moreover, creating the attachment separate from the invention disclosure allows the inventor to incorporate previously generated work related to their invention, which provides for a user friendly and efficient method of creating and distributing an invention disclosure within an organization or company.

Referring now to the Hager et al. patent, an automation of procedures in a local area network (LAN) environment is disclosed. The procedures are automated in a data processing system with regard to the invention disclosures stored therein. As correctly noted by the Examiner, Hager et al. fails to disclose an attachment for the invention disclosure being created separate from the invention disclosure and then being attached thereto.

The Examiner takes Official Notice that it is well known in the art at the time of the invention to send a hyperlink to a document instead of an entire document. In addition, the Examiner cited the Kuzma patent as disclosing attachments being added to e-mail messages. The Examiner has taken the position that it would have been obvious at the time of the invention to modify Hager et al. in view of Kuzma with respect to creating an attachment separately from a document.

The Applicants respectfully submit that even if the references were combined as suggested by the Examiner, the

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claimed invention is still not produced. Reference is directed to column 4, line 65 to column 5, line 6 of Kuzma, which provides:

"Referring now to FIG. 4, there is illustrated an e-mail message format **400** in accordance with a preferred embodiment of the present invention. In the e-mail message format **400** of the present invention, when a user such as **PC 210** of FIG. 2 wishes to send an attachment with an e-mail message to a user such as **PC 212**, the e-mail message **401** is transmitted along with a relatively small attachment reference **402**, instead of actually transmitting the entire attachment file along with e-mail message **401** as is done in prior art e-mail systems." (Emphasis added.)

As highlighted above in the underlined text, the attachment with the e-mail message is actually a pointer that points to the actual location of the attachment, i.e., a hyperlink. Kuzma essentially discloses what the Examiner has stated as Official Notice - which is to "send a hyperlink to a document instead of sending the entire document." The Applicants submit that Kuzma still fails to provide the noted deficiencies in Hager et al. - which is to include an attachment with the invention disclosure, wherein the attachment is created separate from the invention disclosure and is attached to the invention disclosure.

Moreover, since Kuzma fails to provide the noted deficiencies, there is no motivation to selectively combine the references as suggested by the Examiner. As the Examiner is aware, obviousness can only be established by combining or

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modifying the teachings of the prior art in an attempt to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention.

At the time of the invention, Hager et al. discloses in a local area network (LAN) environment automated procedures in a data processing system with regard to the invention disclosures stored therein. As correctly noted by the Examiner, Hager et al. fails to disclose an attachment for the invention disclosure being created separate from the invention disclosure and then being attached thereto. Instead, all of the information for the invention disclosure is included therein.

Kuzma discloses an e-mail message with a hyperlink to an attachment - but fails to disclose including such an attachment to an invention disclosure. As recited in Claim 2 of the present invention, a notification message sent to a first group of users includes a hyperlink to the invention disclosure. Consequently, Kuzma fails to teach or suggest including an attachment to a document - such as an invention disclosure. Instead, Kuzma simply discloses an e-mail message with a hyperlink to an attachment.

Accordingly, it is submitted that amended independent Claim 1 is patentable over Hager et al. in view of Kuzma. Amended independent Claims 12, 22, 31, 42, 52 and 61 are similar to amended independent Claim 1. Therefore, it is submitted that these claims are also patentable over Hager et al. in view of Kuzma. In view of the patentability of the

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amended independent Claims 1, 12, 22, 31, 42, 52 and 61, it is submitted that their dependent claims, which recite yet further distinguishing features of the invention, are also patentable. These dependent claims require no further discussion herein.

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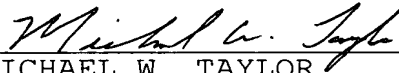
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CONCLUSION

In view of the amendments to the claims and the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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